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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,889	01/30/2004	Kyung-geun Lee	1793.1171	4187

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EXAMINER	
DINH, TAN X	

ART UNIT	PAPER NUMBER
2627	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/766,889	LEE, KYUNG-GEUN	
	Examiner	Art Unit	
	TAN X. DINH	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *29-32* is/are allowed.

6)☐ Claim(s) *1-28 and 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1) The preliminary amendment filed 8/30/2006 is acknowledged. New claim 33 has been added.

2) The I.D.S filed 3/25/2004, 10/03/2006 and 12/15/2006 have been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

3) Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

4) The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested:

OPTICAL DISC HAVING TRANSITION AREAS FOR SMOOTHLY REPRODUCING.

5) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time-wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the

reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6) Claims *1-33* are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims *1-32 and 41* of copending Application No. 10/766,958. Although the conflicting claims are not identical, they are not patentably distinct from each other because.

a) Claims *1-14 and 41* of copending application No. 10/766,958 recite the all the subject matter as claimed in claims *1-14 and 33* of this instant application, such as, a reproduction only optical information storage medium having plurality of areas and at least one transition area located between two adjacent areas, *except that*

one recites the reproduction only optical information storage medium itself and *the other* recites a method for recording information data thereof. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

b) Claims *15-28* of copending application No. 10/766,958 recite the all the subject matter as claimed in claims *15-28* of this instant application, such as, a reproduction-only optical information storage medium comprising a burst cutting area (BCA), a lead-in area, a user data area, a lead-out area, and a transition area located in at least one of an area between the BCA and the lead-in area, an area between the lead-in area and the user data area, and an area between the user data area and the lead-out area, wherein the BCA, the lead-in area, the user data area, and the lead out area are formed of pits, *except that* one recites the reproduction only optical information storage medium itself and *the other* recites a method for recording information data thereof. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

c) Claims *29-32* of copending application No. 10/766,958 recite

the all the subject matter as claimed in claims 29-32 of this instant application, such as, a reproduction-only optical information storage medium comprises a burst cutting area (BCA), a lead-in area, a user data area, a lead-in area and a transition area, wherein at least one of the BCA, the lead-in area, the user data area and the lead-out area is divided into a plurality of sub-areas, and wherein the transition area is located between two adjacent sub-areas, *except that* one recites the reproduction only optical information storage medium itself and *the other* recites a method for recording information data thereof. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7) Claims *1 and 33* are further provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims *1,4,5,11,14 and 15* of copending Application No. 11/527,685. Although the conflicting claims are not identical, they are not patentably distinct from each other because.

a) Claims *1,4 and 5* of copending application No. 11/527,685 recite the all the subject matter as claimed in claims *1 and 33* of this instant application, such as, a reproduction only optical information storage medium having plurality of areas and at least one transition area located between two adjacent areas and have different track pitches from each other, with slightly difference in languages. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

b) Claims *11,14 and 15* of copending application No. 11/527,685 recite the all the subject matter as claimed in claims *1 and 33* of this instant application, such as, a reproduction only optical information storage medium having plurality of areas and at least one transition area located between two adjacent areas and have different track pitches from each other, *except that* one recites the reproduction only optical information storage medium itself and *the other* recites a method for recording and reproducing information data thereof. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8) Claims *7,8,18,19,31 and 32* are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase " specific pattern " (claims *7,18 and 31*) render(s) the claim(s) indefinite since it was not clear what applicant intended to cover by the recitation " specific pattern " since all patterns formed in the optical recording medium could be considered as specific or normal patterns. The resulting claim(s) do not clearly set forth the metes and bounds of the patent protection desired.

9) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> 10) (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11) Claims *1-5 and 14* are rejected under 35 U.S.C. 102(b) as being anticipated by OTSUKI (5,283,779).

OTSUKI discloses a reproducing-only optical disc as claimed in claim 1, comprising:

A plurality of areas (Fig.3, plurality of areas on the optical disc such as, RZ, CTZ, TZ, GB1, GB2, etc.,);

At least a transition area located between two adjacent areas (Fig.3, transition area TZ, mirror zone RZ).

As to claims 2-4, OTSUKI shows data is recorded in form of pits in the areas and transition area and the pits patterns are the same on every data areas (all of data in every zones as seen in figure 3 is in form of pits and the pits are the same. See also column 4, lines 11-30).

As to claims 5, OTSUKI shows transition area is a mirror (Fig.3, mirror zone RZ).

As to claims 14, OTSUKI shows transition area stores information identify a transition area (Fig.3, TZ).

12) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13) Claims *6-13 and 33* are rejected under 35 U.S.C. 103(a) as being unpatentable over OTSUKI (5,283,779).

OTSUKI discloses all the subject matter as claimed in claims *6-8, except* to specifically show that the pits of the transition area are formed on straight single/specific/random pattern or wobble single/specific/random pattern. However, the pits on optical recording medium could be formed in any desirable choices of forms, sizes and/or shapes and can be positioned at any suitable locations. Therefore, to form the pits of transition area in OTSUKI's optical recording medium as straight single/specific/random pattern or wobble single/specific/random pattern as claimed is deem obvious to someone within the level of skill in the art.

As to claim 33, it would have been obvious to form different track pitch between adjacent areas since the track pitch on optical recording medium can be lay out at any suitable positions, sizes and shapes depend on the design choice or application of the recording medium.

14) Claims *15-28* are rejected under 35 U.S.C. 103(a) as being unpatentable over OTSUKI (5,283,779).

OTSUKI discloses a reproducing-only optical disc as claimed in claim 15, comprising a lead-in area (Fig.2A, AR_{IN}), a user data area (Fig.2A, AR_{USE}), a lead-out area (Fig.2A, AR_{OUT}), a

transition area located between two adjacent areas (Fig.3, transition area TZ, mirror zone RZ), *except* to specifically show a burst cutting area (BCA). However, the burst cutting area (BCA) is old and widely used in the optical recording art, as admitted by applicant in the specification, page 1, therefore, one of ordinary skill in the art at the time of the invention was made would have been modify to include a burst cutting area (BCA) in OTSUKI's optical recording medium as claimed.

As to claims 16-19, it would have been obvious to form multiple transition areas between BCA, lead-in area, data area and lead-out area in OTSUKI's optical recording medium as claimed since the transition areas can be placed at different locations on the optical medium for smoothing the reading process. Further, the pits on optical recording medium could be formed in any desirable choices of forms, sizes and/or shapes and can be positioned at any suitable locations.

As to claims 20-27, it would have been obvious to form track pitch on BCA, lead-in area, user data area and lead-out area increase from each other, decrease from each other, the same or different from each other as claimed since the track pitch on optical recording medium can be lay out at any suitable positions,

sizes and shapes depend on the design choice or application of the recording medium.

As to claim 28, the method of using transition area for storing identification information is old and widely used in optical recording art (see YUMIBA et al, US 6,661,768).

15) Claims 29-32 are allowed.

16) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the *patentable novelty must be clearly shown* in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments *avoid* such references and objections. See 37 CFR § 1.111(c).

Form PTO-892 is attached herein.

17) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN XUAN DINH whose telephone number is (571)272-7586. The examiner can normally be reached on MONDAY to FRIDAY from 9:00AM to 5:00PM.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be

obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov/. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TAN DINH
PRIMARY EXAMINER
March 12, 2007